

Application No. 09/980,388
Applicant: Inge KRUSE et al.
Second Amendment Under R1.116 Dated June 14, 2004

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The Advisory Action dated November 4, 2003, indicates that the amendment dated October 14, 2003, will be entered upon the filing of a Notice of Appeal. Since a Notice of Appeal was previously filed, Applicants assume that this amendment has already been entered. If the amendment dated October 14, 2003, has not been entered, then Applicants respectfully request that amendment be entered now.

In addition, Applicants now introduce new claims 29-32. New claim 29 is supported by, for example, Example 1; new claim 30 by Example 6; new claim 31 by Example 7; and new claim 32 by Example 8. Applicants do not believe that the introduction of new claims 29-32 introduces any new matter.

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The sole issue for consideration is the rejection of claims 11-27 under 35 USC §103(a) as being obvious over Beiersdorf AG, WO 96/18352. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

At the outset, Applicants note that at the very bottom of page 2 of the Office Action dated July 11, 2003, the Examiner promised to provide a translation of the Beiersdorf reference. To date, Applicants have not received the promised translation. Applicants respectfully request that the Examiner provide the translation now.

In the middle of page 7 of the amendment dated October 14, 2003, Applicants indicated that U.S. Patent No. 5,952,373 may be an equivalent to the Beiersdorf reference. Applicants now believe that U.S. Publication No. 2002/0142012 A1, published on October 3, 2002, is probably the actual equivalent.

In either case, Applicants submit that the Examiner has not made out a *prima facie* case of obviousness. On the second page of the Advisory Action dated November 4, 2003, the Examiner commented that Applicants had not addressed this rejection. This was because Applicants believed the thrust of the Examiner's rejection only applied to the "preventing" aspect of the claims and, therefore, when the "preventing" aspect of the claims was canceled, Applicants did not believe the rejection applied to the remaining "treatment" aspect of the claims.

In this regard, the Examiner points out that the reference compositions can be used as "sunscreens." This would imply a preventative function, i.e., protection of the skin against the

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damaging effects of sunlight. However, this does not teach or suggest a remedial function, i.e., alleviation of preexisting damage caused by sunlight. The Examiner has nowhere explained why the fact that the Beiersdorf reference teaches the compositions described therein could be used as a sunscreen would have suggested to persons skilled in the art that the compositions could also be used to treat preexisting damage caused by sunlight, i.e., sunburn. In the absence of such an explanation, Applicants submit that the Examiner has not made out a *prima facie* case of the obviousness of the present claims.

The Examiner also comments that the Beiersdorf reference teaches the treatment and prevention and protection of "cells which participate in the immune response of the skin," and the "aid" of "the immune system which is already damaged." The Examiner has not explained how such teaching relates to sunburn, and would have led persons skilled in the art to expect that the compositions of the Beiersdorf reference would have been effective in treating sunburn. Again, in the absence of such an explanation, Applicants submit that the Examiner has not made out a *prima facie* case of the obviousness of the present claims.

Finally, Applicants respectfully request that special consideration be given to new claims 29-32, which relate to specific supported combinations of ascorbic acid or a derivative thereof and α -glucosylrutin. The Beiersdorf reference does not teach or suggest such combinations. The Beiersdorf reference only mentions ascorbic acid and certain derivatives thereof in passing in a "shotgun" disclosure of literally thousands of antioxidants that *might* be added to the compositions disclosed therein. There does not appear to be a single example in the Beiersdorf

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reference of a composition containing either ascorbic acid or a derivative thereof. Consequently, the motivation of a person skilled in the art to include ascorbic acid in the compositions in the Beiersdorf reference is speculative at best. It should be pointed out that the ascorbic acid derivative of new claim 30 is not even listed in the Beiersdorf reference.

In short, Applicants believe that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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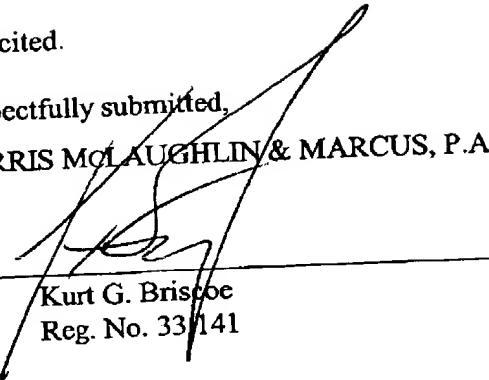
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


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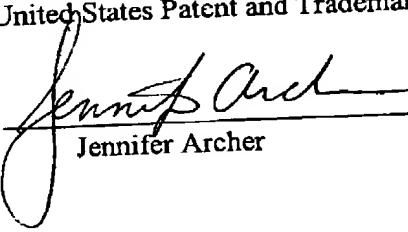
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Second Amendment under 37 CFR § 1.116 (10 pages total) is being transmitted via facsimile to the United States Patent and Trademark Office on the date indicated below:

Date: June 14, 2004

By


Jennifer Archer